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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,501	01/08/2004	Shoji Ichinohe	4710-0105P	5138

2292 7590 11/03/2005

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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/752,501

Applicant(s)

ICHINOHE, SHOJI

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/14/05 Amendment.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The Applicants' amendment filed on June 14, 2005 was received. Claim 2 is deleted. Claims 1, 3-5 and 7 are amended. Now, Claims 1 and 3-7 are pending.
2. Claim objection(s) in the previous Office Action (Paper No. 0305) is/are removed.
3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 0305) is/are removed.
4. Claim rejection(s) under 35 USC 102 as anticipated by Petroff (EP 995 771) in paragraph 5 of the previous Office Action (Paper No. 0305) is/are removed.
5. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 0305).

***Claim Rejections - 35 USC § 102 and 103***

6. Rejection of Claims 1 and 5-7 under 35 USC 102(b) as being anticipated by Ichinohe (US 5 288 831) and rejection of Claims 3-4 under 35 USC 103(a) as being unpatentable over Ichinohe alone or optionally in view of Schilling (US 4 150 048) are maintained because the rejection is adequately set forth in paragraphs 4 and 7-8 of Paper No. 0305. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants' primarily argue that Ichinohe's free polyethers including polyethers containing terminated with alkenyl group and polyethers without alkenyl group (obtained after aqueous acid solution treatment) cannot be removed by vacuum distillation. (Remarks, page 6, 3<sup>rd</sup> paragraph to page 8, 3<sup>rd</sup> paragraph) However, Applicants' specification (page 7, 1<sup>st</sup> paragraph) clearly indicates that vacuum distillation is used to efficiently remove the unreacted polyether.

(Emphasis added) Especially, Ichinohe's purification process comprises both acid treatment and vacuum distillation. (col. 6, lines 3-14) Therefore, Examiner has a reasonable basis to believe Ichinohe's polyethersilicone should be much purer than that of Applicants'. As such, it also renders Applicants' argument irreverent

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regarding the “speculated” amount of Ichinohe’s residual free polyether as calculated by Applicants.

For Applicants’ argument in Remarks (page 8, 4<sup>th</sup> paragraph to page 9, 1<sup>st</sup> paragraph), although Ichinohe focuses mostly on silicones modified at a silicon atom within the chain in Examples. However, this is merely a preferred embodiment. Certainly, Ichinohe does not teach away the modification of the silicones at a silicon atom at the chain end(s). See the formulae in col. 3, lines 1-44, wherein n can be 0. Since the present invention is anticipated by Ichinohe, the argument of unexpected results is improper.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

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of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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klp

October 28, 2005

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng  
Primary Examiner  
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